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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,155	11/25/2003	Theodore R. Sana	10030511-1	8586

7590 05/22/2007
AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

KIM, YOUNG J

ART UNIT	PAPER NUMBER
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1637

MAIL DATE	DELIVERY MODE
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05/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/722,155	SANA ET AL.	
	Examiner	Art Unit	
	Young J. Kim	1637	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

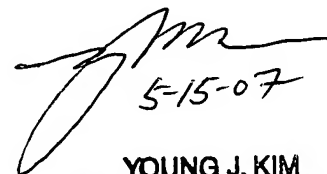
REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Young J. Kim
Primary Examiner
Art Unit: 1637

5-15-07

Continuation of 11. does NOT place the application in condition for allowance because: The rejection of claims 1-7 and 9 under 35 U.S.C. 102(e) as being anticipated by Cronin et al. (of record), made in the Office Action mailed on September 14, 2006 is maintained for the reasons already of record. Applicants' arguments presented in the Amendment received on May 3, 2007 have been fully considered but they are not found persuasive for the following reasons. Applicants' arguments are addressed in the same order they were received. Applicants state that the language, "providing one or more biopolymer subunit precursors at each of multiple feature locations on said surface to form said plurality of said biopolymers" is a statement describing the general process by which the "plurality" of biopolymers is formed and that this statement is, "subsequently limited by the language 'wherein, for one or more feature locations comprising said degenerate biopolymers, said biopolymer subunit precursors comprise a mixture of biopolymer subunit precursors for forming said degenerate biopolymers at said feature location.'" (page 6, 1st paragraph, Response). Applicants state that claim 1, thus, properly interpreted includes a limitation not taught by Cronin et al., "wherein, for one or more feature locations comprising said degenerate biopolymers, said biopolymer subunit precursors comprise a mixture of biopolymer subunit precursors for forming said degenerate biopolymer at said feature location." This argument is not found persuasive. It is respectfully submitted that the Applicants' representative's interpretation of the discussed claim is inconsistent with the full scope of the claim. Claim 1, for example, is replete with the recitation of the phrase, "one or more." Hence, the method described by claim 1, embraces a method for synthesizing a plurality of biopolymers comprising in each round of multiple rounds of subunit additions, providing ONE biopolymer subunit precursor at each of multiple feature locations on the surface, wherein for ONE feature location comprising said degenerate biopolymers, said biopolymer subunit precursors comprise a MIXTURE of biopolymer subunit precursors for forming said degenerate biopolymers on said feature location. In this aspect, the method reads on generating an array, which has ONE feature location comprising degenerate biopolymers. As previously discussed in the Office Action, to which Applicants have completely ignored in their response is the FACT that the instant specification defines the term, "degenerate biopolymers" as being biopolymers that comprise one or more sites of degeneracy, down to a single nucleotide which is degenerate. The specification further discloses that the nucleotide of the degenerate sites are degenerate nucleotides where the nucleotide(s) of a respective degenerate site DIFFER from nucleotides in corresponding position of another biopolymer" (see Applicants' specification on section [0032] and page 5 of the previous Office Action). As already pointed out the method disclosed by Cronin et al. fabricates an array comprising a plurality of probes which have one nucleotide which are different from the CORRESPONDING position of another probe (see image of the Figure as well as the description found on page 5 of the previous Office Action). So, it is clear that Cronin et al. disclose a method of fabricating, wherein the method array comprises at least ONE feature location comprising "degenerate probes" (consistent with Applicants' own definition of the term), said method comprising, in each round of multiple rounds of subunit additions (each round of monomer addition, when growing the probe), providing ONE nucleotide subunit at each of multiple feature locations (as there are many feature locations on the array of Cronin et al.) on said surface to form said plurality of said biopolymers on said surface (it cannot be disputed that the microarray of Cronin et al. comprises a plurality of polynucleotide probes), wherein for ONE feature location comprising said degenerate biopolymers, said biopolymer subunit precursors comprise a mixture of biopolymer subunit precursors for forming said degenerate biopolymers at said feature location. While the term, "mixture" may connote a combination of different nucleotides, this interpretation cannot be instituted for the embodiment for "providing ONE biopolymer subunit," and thus giving the broadest interpretation of the claim term, "mixture" as that which includes a plurality of the same nucleotide precursors, the disclosure of Cronin et al. would fully anticipate the invention as claimed. Applicants' arguments with respect to claims 2-7 and 9 ultimately depends from the inconsistent interpretation of claim 1 in all its metes and bounds, the arguments which have already been discussed above, and thus maintained herein. The rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over Cronin et al. (of record) in view of Baldeschwieler et al. (of record), made in the Office Action mailed on September 14, 2006 is maintained for the reasons of record. Applicants do not present any new arguments for the instant rejection but relies on the rejection of record, which have been fully rebutted above. Hence, the instant rejection is maintained herein. The rejection of claims 1-9 and 33-38 as being unpatentable over Hanks et al. (of record) in view of Baldeschwieler et al. (of record), made in the Office Action mailed on September 14, 2006 is maintained for the reasons already of record. Applicants' arguments presented in the Amendment received on May 3, 2007 have been fully considered but they are not found persuasive for the following reasons. Applicants' arguments are addressed in the same order they were presented. Applicants' arguments solely rely on their asserted definition of the term, "mixture." As already discussed above, claims in their full embodiment, would need to embrace a plurality of the same nucleotide monomers. Applicants are advised to amend the claim to recite that the mixture includes a plurality of different nucleotide monomers. However, the entry/non-entry of after final amendments will be subject to the guidance set forth in MPEP 714.13. The rejections are maintained for the reasons for record.



5-15-07

YOUNG J. KIM
PRIMARY EXAMINER